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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/868,256 | 07/15/2001 | Hidekazu Tanaka | AA374F | 7253 |

27752 7590 12/18/2002

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EXAMINER

YU, GINA C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1617

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/868,256 | Applicant(s) TANAKA ET AL. | |
| | Examiner Gina C. Yu | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 1, 2002 has been entered. Claims 1, 2, and 4-10 are pending.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sumida (English translation of Japanese Kokai application no. HEI 4[1992]-48925) in view of Motono (US 4985455), or alternatively, in view of Sugizaki (English translation of Japanese Kokai application no. 3-115208).

Sumida teaches transparent microemulsion composition comprising (a) 0.1-30.0wt % of nonionic surfactants which include polyoxyethylene castor oil or hardened castor oil derivatives; (b) 0.001-20 wt % of ionic surfactants which include polyoxyethylene alkyl ether phosphate; (c) 0.1-30wt % of oil; and (d) 40-99 wt % of water. See Translation, p. 2 – p. 6. Polyoxyethylene sorbitol tetraoleate is disclosed on p. 5, group 10. Example 1 on p. 8 shows the use of polyhydric alcohol. The types of oil and additives that may be used for the invention are also discussed. The reference

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further teaches that the preferred ratio of nonionic surfactant to oily substance is 1: 1-3, which meets instant claim 2. It teaches that at a high ratio of surfactant to oil the skin safety and feel are degraded. See p. 3, last paragraph. The reference further teaches that the preferred ratio of ionic surfactant to oil is 1:0.01-2.0. See p. 6, paragraph 3.

Although the specific ratio of each surfactants are not disclosed in the reference, examiner views that given the teachings of the preferred surfactants and their amounts in the composition, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experiments.

While Sumida teaches that the disclosed ionic surfactants are used alone or in combination of two or more, the reference fails to provide particular formulation comprising polyoxyethylene sorbit tetraalkyl ester.

Motono teaches a clear cosmetic emulsion composition comprising POE sorbitol tetraoleate. See Example 2. See also Example 3.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of three conventional nonionic surfactants well known in cosmetic emulsion art. It would follow that the recited claims define prima facie obvious subject matter.

Sugizaki teaches a transparent cosmetic composition comprising polyoxyethylene sorbitol tetraoleic acid ester. The reference teaches that the composition has good emollient and moisturizing action, as well as good appearance, skin feel and stability. See Translation, p. 2, Detailed description of the invention. Table 1 shows clear oily compositions comprising PEO (6) sorbitol tetraoleic esters and POE (11) hydrogenated castor oil.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the formulations in Sumida by adding polyoxyethylene sorbitol tetraoleate as motivated by Sugizaki because of the expectation of successfully producing a transparent cosmetic composition which provide long shelf-life as well as non-greasy feel and moisturizing effect on skin.

2. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyanagi et al. (U.S. Pat. No. 5474776) ("Kayanagi") in view of Motono, or alternatively, in view of Sugizaki.

Koyanagi teaches transparent cosmetic composition comprising (a) hydrophilic nonionic surfactants which may include the surfactants of instant claim 8 (a); (b) liquid oil; (c) water-soluble compound which may include polyhydric alcohol; (d) water. See abstract; col. 2, line 23 – col. 6, line 27. The reference mentions polyoxyethylene sorbitan fatty acid ester and polyoxyethylene hardened castor oils are particularly preferred, and may teaches that the surfactants may be used singly or in combination, meeting instant claim 1. See col. 3, lines 33 – 37. Instant claim 9 is met by the

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disclosure of the types of oil used in the invention in col. 4, lines 50 – 67. The additives are disclosed in col. 6, lines 2 – 12, meeting instant claim 10. The reference further teaches that (a) 1-30 wt % of surfactants (b) 1-60 wt % of liquid oil; (c) 10-70 wt % of water-soluble compound; and (d) 1-87.99 wt % of water. See col. 3, line 38 - col. 5, line 7.

While Koyanagi discloses the use of POE tetraoleate in the composition, the reference fails to provide particular motivation select the ester.

Motono, discussed above, disclosed a clear oil-in-water emulsion cosmetic composition comprising a POE tetraoleate.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. See In re Kerkhoven. In this case, the concomitant use of two conventional nonionic surfactants well known in cosmetic art would have been obvious to a skilled artisan at the time the instant invention was made.

Sugizaki, discussed above, teaches that POE tetraoleate is used to formulate a clear oil based composition, and provides good emollient and moisturizing action, as well as good appearance, skin feel and stability. See Translation, p. 2,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition disclosed in Koyanagi by adding POE tetraoleate as motivated by Sugizaki, because of the expectation of successfully

producing a cleansing composition with good emolliency, moisturizing properties, aesthetic qualities, good skin feel, and stability.

Response to Arguments

Applicant's arguments filed October 1, 2002 have been fully considered but they are not persuasive.

Applicants assert that the low water-content of the Sugizaki formula teaches away from employing the POE sorbitol tetraoleate in a high water-content composition. Examiner respectfully disagrees, as there the reference does indicate the specific beneficial properties of the surfactant that is desirable for a cosmetic formulation. The teaching regarding reduced stability and clarity in p. 3, second paragraph concerns with that particular oil-based formulation. There is no teaching or suggestion, either expressed or implied, to indicate that the use of the POE sorbitol tetraoleate in a high-water content formulation per se cause the instability or cloudiness in oil-in-water microemulsion compositions, such as those taught in Sumida. In fact, POE sorbitol tetraoleate is one of the nonionic surfactants suitable for the transparent microemulsion in Sumida.

While applicants assert that the claimed water level of the Koyanagi invention is below 40 %, it must be noted that the specification of the prior art in fact teaches that up to 87.99 % of water may be preferably used. See col. 5, lines 1 – 7.

Applicants' argument that there is no teaching in Kayanagi to use tetra alkyl esters is rendered moot in view of the new ground of rejection as discussed above.

Conclusion

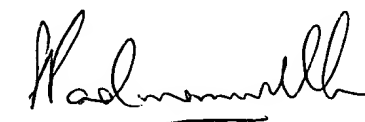
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
December 15, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

12/16/02